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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,106	02/28/2001	Koji Egashira	33082M072	8270

7590 09/03/2004

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EXAMINER

PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/801,106	Applicant(s) EGASHIRA ET AL.	
	Examiner Joseph L. Perrin, Ph.D.	Art Unit 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-17, 21, 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 18, 22-23, 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 August 2004 has been entered.

Response to Arguments

2. In view of applicant's Amendment filed 10 August 2004, the status of the application is as follows:

35 U.S.C. §102 Rejections over Thompson

Applicant's arguments in view of the Amendment filed 10 August 2004, with respect to claims 9-13, 15, 16, 21 & 24-25 have been fully considered and are persuasive. The rejections of claims 9-13, 15, 16, 21 & 24-25 have been withdrawn.

The rejection of claims 18 & 22-23 are maintained for at least the following reasons: Re claim 18, applicant argues that Thompson "fails to inherently or explicitly disclose: 'a processing container having an inner surface facing the circular plates; and an ejecting orifice formed on the

inner surface of the processing container.” This is not persuasive because Thompson discloses at least one ejecting orifice on an inner face of the processing container (see, for instance, Figures 1-4, nozzles 28/30 with ejecting orifices located on the inner surface of container 12).

Applicant's argument that the claimed nozzles refer to Figure 5, nozzle parts 74a and 74b, rather than nozzle parts 54 and 56 which are similar to Thompson, is not persuasive because the claimed ejecting orifice reads on either set of the nozzle parts. Although nozzle parts 74a and 74b do appear to be arranged differently relative to the wafer holding member and circular plates, the claims do not appear to structurally distinguish such arrangement, *i.e.* the claims still read on either arrangement. Even if, *arguendo*, the ejecting orifice arrangement was defined structurally in the claim as such, rearrangement of parts would be considered within the skill of an ordinary artisan. Re claims 22-23, as previously noted, limitations of fluids usable in an apparatus is considered intended use and given little patentable weight. It has been held that the recitation that an element is capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Moreover, MPEP 2115 and caselaw is replete with teachings disclosing that expressions relating an apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666,

667 (Bd. App. 1969). Furthermore, “[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims.” *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Even if, *arguendo*, the processing fluid limitation was given significant patentable weight, Thompson discloses (for instance, col. 5, lines 58-65) such processing fluids which read on applicant’s claims.

35 U.S.C. §103(a) Rejections over Thompson and Thoms

The rejection of claims 14 & 17 is also withdrawn because claim 10 of which they depend is not anticipated or obvious.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 18, 22-23 & 26 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,022,419 to Thompson *et al.* (hereinafter “Thompson”).

Re claims 18 & 26, Thompson discloses a liquid processing apparatus with processing container 12, nozzle 28 located on the inner surface of the processing container and having a plurality of orifices (Figure 3), wafer holder 26 built with circular plate holders 122 & 126, for holding a plurality of wafers, the container (including wafers) being rotatable, the orifices being capable of spraying a processing fluid towards

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a surface of a circular plate facing the inner surface of the processing container (see entire reference of Thompson et al., for instance, Figures 1-4, and relative associated text). It is noted that applicant's limitation directed to the substrates (*i.e.* work to be treated) is considered intended use and given little patentable weight. It has been held that the recitation that an element is capable of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Moreover, MPEP 2115 and caselaw is replete with teachings disclosing that expressions relating an apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Re claims 22 and 23, Thompson further discloses the processing fluid being a cleaning liquid (DI H₂O) and a drying fluid (N₂), respectively (see col. 5, lines 58-65).

Allowable Subject Matter

5. Claims 9-17, 21 & 24-25 are allowed.

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6. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Thompson (cited above), fails to teach each and every limitation of the instant invention. Specifically, Thompson fails to teach or suggest the claimed nozzle assembly, which is disclosed as an essential element of claimed invention, as described in claims 9-17, 21 & 24-25 and argued by applicant in the Amendment filed 10 August 2004.

7. For at least the foregoing reasons, claims 9-17, 21 & 24-25 are believed to recite patentable subject matter.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph L. Perrin, Ph.D.
Examiner
Art Unit 1746



jlp